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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,862	08/20/2001	Frederic Dat		5677

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EXAMINER

BOTTORFF, CHRISTOPHER

ART UNIT PAPER NUMBER

3618

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/913,862

Applicant(s)

DAT, FREDERIC

Examiner

Christopher Bottorff

Art Unit

3618

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-14, 16-26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9, 11, 13, 17, 18, 20, 21, 23 and 25 is/are rejected.
- 7) ☒ Claim(s) 10, 12, 14, 16, 19, 22, 24, 26 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

The amendment filed December 3, 2003 has been entered. Claims 15 and 27 are canceled. Claims 9-14, 16-26, and 28 are pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 11, 20, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paris US 5,899,483 in view of Cubberley US 3,145,028.

Paris discloses a device having a base 8, a heel release 7, and a heel-piece 11, 12. See figures 1-4. The base 8 includes a sole fixed flat on the snowboard and two lateral wings extending up the sides of the sole corresponding to the two lateral sides of a shoe. The heel release 7 includes an upper part and lower part, wherein the upper part extends vertically and is placed transversally at the rear of the base. The heel release 7 is divided in its lower part into two lateral branches 18, 19 that each interlock to a wing of the base by a pin 9. The heel release 7 is mounted pivotally on pin 9 under the action of spring 24 and the upper part of the heel release is able to bear against the rear of the shoe. See Figure 1. Each spring 24 is an angular action spring that surrounds the corresponding pin, and has one end pressing on the base and the other end contacting the corresponding lateral branch of the heel release. See column 5,

lines 8-19. Also, the heel-piece 11, 12, fixed on the shoe, includes two lateral side extensions that are adapted to cooperate with stop means 16, 17, 20 provided on each of the wings, and the side extensions are removably engaged between the stop means. See Figures 2 and 4; column 3, lines 62-67; and column 4, lines 4-6 and lines 20-31. Also, when the heel piece 11, 12 is locked into a normal position in the base, each lateral branch 18, 19 has a lower part located under the pin 9, is housed under the pressure of a spring 24, and is above one part of a side extensions of the heel piece 11, 12. See Figure 1.

Paris does not disclose that the heel piece is removable from the shoe. However, Cubberley teaches that the practice of removably fixing a heel piece 12 to a shoe was old and well known in the art at the time the invention was made. See Figures 1-3 and column 2, lines 20-24. From the teaching of Cubberley, removably fixing the heel piece of Paris to the shoe would have been obvious to one of ordinary skill in the art at the time the invention was made. This would allow a user to remove unnecessary projections from the shoe when the user is walking about, rather than using the board.

Claims 13, 17, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paris US 5,899,483 in view of Cubberley US 3,145,028 as applied to claims 9 and 20 above, and further in view of Gignoux US 6,105,993.

Paris does not disclose a mobile blade or a handle. However, Gignoux teaches a mobile blade 36 that is linked to the back part of a heel release 26 by one of its ends,

forms a loop behind the back part of the heel release, and another end that is free passes through an opening in the heel release to come into contact with the heel of a shoe. See figure 1. Also, the blade serves as a prehension handle that is easy to hold. From the teachings of Gignoux, providing the device of Paris with a mobile blade, that also serves as a handle, would have been obvious to one of ordinary skill in the art at the time the invention was made. This would offer a user a convenient means of holding the heel release.

Claims 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paris US 5,899,483 in view of Cubberley US 3,145,028 as applied to claims 9 and 20 above, and further in view of Quintana et al. US 5,947,507.

Paris does not disclose two housings on the front of the wings of a base adapted to accommodate flat parts on the sides of a shoe sole. However, Quintana et al. teaches the old and well known practice of forming two housings 46 on the front wings of a base with shapes that correspond to the flat parts on the sides of a shoe such that the housings are adapted to accommodate flat parts on the sides of a shoe sole. See figures 1 and 5. From the teachings of Quintana et al., providing the device of Paris with two housings on the front of the wings of a base would have been obvious to one of ordinary skill in the art at the time the invention was made. This would effectively secure the boot to the base.

***Allowable Subject Matter***

Claims 10, 12, 14, 16, 19, 22, 24, 26, and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed December 3, 2003 have been fully considered but they are not persuasive.

Arranging the heel piece of Paris such that it is removable from the shoe would have been obvious, as taught by Cubberley. Also, there is no need to modify Paris to provide the heel piece as removably engaged between the stop means. Since the shoe and heel piece of Paris detach from the base, the heel piece of Paris is removably engaged with the stop means.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (703) 308-2183. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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